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10/23/2003

Jay A. Goldstein

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Pabst Patent Group LLP

1545 PEACHTREE STREET NE

SUITE 320

ATLANTA, GA 30309

EXAMINER

SCHLENTZ, NATHAN W

ART UNIT

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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAY A. GOLDSTEIN, MICHAEL ROTHMAN,
and WHE-YONG LO

Appeal 2010-006562
Application 10/691,928
Technology Center 1600

Before TONI R. SCHEINER, LORA M. GREEN, and STEPHEN WALSH,
Administrative Patent Judges.

WALSH, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

Appellants request rehearing of the Decision on Appeal entered November 22, 2011, which affirmed the rejections of claims 1-3 and 7-17 on grounds of obviousness. We have reconsidered the evidence as requested, but adhere to the Decision affirming the rejection.

BACKGROUND

Appellants claim a topical antifungal composition comprising an antifungal and a low to low-medium potency anti-inflammatory steroid “wherein the composition does not cause the steroids [sic] to penetrate the skin and cause undesirable local side effects.” (Claim 1.)

The Patent Examiner found the composition would have been obvious over Quigley’s description of topical antifungal compositions comprising an antifungal and a low-mid strength steroidal anti-inflammatory. (Ans. 6-8.) The Examiner relied on Quigley’s teaching that steroids that penetrate the skin cause undesirable side effects (*id.*, citing findings at Ans. 3), and concluded that it would have been obvious to formulate an antifungal with low to low-medium potency steroids, e.g. 0.05% desonide (*id.*). This Board affirmed the obviousness rejection over Quigley.

Appellants request rehearing on the grounds that:

- (i) “[t]he working examples in Quigley teach away from low to low-medium steroid formulations” (Req. 2);
- (ii) “[w]hile the Board alleges that Quigley discloses the same problem to be solved as the present application, it fails to recognize that the problem is allegedly solved [in Quigley] by selecting a particular class of antifungal agents, not by decreasing the potency of the steroid formulation” (*id.* at 3-4);
- (iii) “[t]he fact that 0.05% desonide is in a long list of steroid formulations is not a teaching or suggestion to select that particular formulation let alone a low to low-medium potency steroid formulation and therefore does not render the claimed methods obvious” (*id.* at 4);
- (iv) the Decision was based on hindsight (*id.*); and

(v) “[t]he results presented in Dr. Goldstein’s declaration are unexpected” (*id.* at 7-8.)

ANALYSIS

We have reconsidered the Decision as requested, but adhere to the affirmance for the reasons given in the Decision. We do not agree that working examples outweigh Quigley’s guidance to avoid steroid-caused side effects, and are therefore unpersuaded by argument (i). Argument (ii) simply contradicts Quigley’s disclosure that steroids cause side effects, and Appellants provide no evidence to support the argument that a person of ordinary skill in the art would read Quigley to teach selecting antifungals to negate steroid-caused side effects. “[T]he ‘evidence’ of motive will likely consist of an explanation of the well-known principle or problem-solving strategy to be applied.” *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1366 (Fed. Cir. 2006). On this record, the evidence supports the Examiner’s finding that Quigley taught selecting steroids to reduce steroid-cause side effects, not antifungals as Appellants argue. Given Quigley’s teaching on that point, we continue to agree with the Examiner that a person of ordinary skill in the art would have taken Quigley’s teachings as guidance to choose low and low-medium potency steroids such as 0.05% desonide. We therefore again reject Appellants’ “hindsight” argument. Finally, for the reasons stated in the Decision, the results shown in the Goldstein Declaration were expected, not unexpected.

SUMMARY

We deny the requested relief.

Appeal 2010-006562
Application 10/691,928

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

DENIED

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